

### **REMARKS**

Claims 1 through 15 are pending in this application. Claims 1 through 15 are amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application.

#### **I. Amendments for claims 1 through 15 under 37 C.F.R. 1.116**

Claims 1 through 15 were amended for only formality reasons to make sure proper antecedent basis was made and if not, then corrections were made in order to assist the examiner and expedite the compact prosecution of this application. Entry of the foregoing amendments to claims 1 through 15 is proper under 37 C.F.R. 1.116(b) because those amendments are only for formality reasons.

#### **II. Claim Rejections - 35 USC § 102**

Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Cheney et al. U.S. Pat. No. 6,519,283 (hereinafter Cheney). The Applicant respectfully traverses.

No claim is anticipated under 35 U.S.C. §102 (b) unless all of the elements are found in exactly the same situation and united in the same way in a single prior art reference. As mentioned in the **MPEP §2131**, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). The identical invention must be shown in as

complete detail as is contained in the patent claim. *Id.*, “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970), and MPEP 2143.03.

**1. Cheney fails to disclose an outputting unit outputting said analog personal computer signal generated from said signal dispensing unit, where said signal dispensing unit dispenses an output signal output from a personal computer in the form of an analog signal.**

In paper no. 13, the Examiner states that col. 7, lines 19-37 of Cheney must be looked at concerning figure 5 of Cheney. Looking at col. 7, Cheney states, that the 2:1 MUX 202 selects between a decompressed digital video or the uncompressed video, *i.e.*, the analog (or digital) video received through the DMSD. In col. 7, lines 30-37, an embodiment shows that there is a selection between the decompressed video, compressed video and the picture in picture display.

However, in col. 8, lines 26-32, Cheney states that “Typical sources for the uncompressed, analog video would be a video cassette recorder (VCR), camcorder, television camera, laser disc, digital video disc player, computer with TV output, cable television analog channel, satellite analog channel, tuner connected antenna (broadcast). Any of these sources may provide a composite television or S-video signal to a digital multi-standard decoder (DMSD) chip which then digitizes the incoming video and sends the digitized video to the integrated decode system for blending of video signals and mixing of graphics.”

Furthermore, col. 7, lines 1-5 states, “If an analog video signal 104 is received, for example,

from a cable, satellite, VCR or tuner source, a digital multi-standard decoder (DMSD) 105 digitizes the analog signal for input to the integrated digital video decode system 100....Note that DMSD 105, along with providing digital conversion of the analog video signal, will be (in one embodiment) the sync master to the video decoder and internal DENC.” Therefore, other than providing the sync signal, the main function of the DMSD is converting the analog signal to a digital signal.

Furthermore, as seen in figure 5, the output of the MUX goes to the OSD (on screen display) for blending with the on screen display graphics which according to col. 7 and col. 8 is digitally blended. Therefore, the output of the MUX must be digital and the input are also digital.

Therefore, in order for the MUX to work properly, the uncompressed video is digitized by the DMSD 105 according to Cheney.

Therefore, col. 7, lines 1-5, col. 8, lines 26-32, and remainder of cols. 7 and 8 clarifies the statement in col. 7, lines 19-37.

The Examiner from paper no. 13 assumes that the MUX will work for all three selections and still be forwarding an unprocessed analog signal from the uncompressed signal. The Applicant asks the Examiner how this is technically possible considering the disclosure of Cheney? How does Cheney provide with the MUX, a pure analog output, a pure digital output and a combined picture in picture output with a multiplexer? The Examiner merely cites a portion of text of Cheney, but that text is clarified in other portions of Cheney as not referring to the output of the DMSD being analog but the signal being processed by the DMSD being originally analog. Therefore, what Cheney is actually referring to is the “original analog signal” coming from the uncompressed video which is then digitized for the MUX by the DMSD. Therefore, unlike what the Examiner states in paper no.

13, Cheney clearly does disclose the digitizing of the analog uncompressed signal.

In paper no. 13, the Examiner disputes that the disclosure of Cheney is referring to the original analog signals and again merely cites a portion of the text of Cheney as “digital or analog signal.” The uncompressed video and the compressed video are combined in the MUX, but the Examiner has no answer how this is done when one is analog and the other is digital. It is clear from above, that DMSD would have to digitize the uncompressed video as disclosed in cols. 7 and 8 of Cheney.

In paper no. 13, the Examiner also argues that the claims do not claim an unprocessed personal computer signal. However, looking at claim 1 (and 6), it can be seen that the claim states, “an outputting unit for outputting said analog personal computer signal generated from said signal dispensing unit.” The same analog personal computer signal from the dispensing unit is also outputted by the outputting unit and therefore, unprocessed, e.g., no analog to digital and back to digital to analog conversion as seen in Cheney. Figure 2 of the present invention supports claims 1 and 6 as signal line from the SDU goes directly to the switching unit and skips the analog to digital converter 21. Therefore, said analog personal computer signal generated from said signal dispensing unit is not disclosed by Cheney.

As stated in the description of the related art (paragraph 0005), the present invention also

clearly mentions this problem with the related art such as Cheney, "To realize the PIP function in the CDT monitor, a scaler integrated circuit (IC) that is used in the LCD monitor is needed. However, when the scaler IC is used, a signal is displayed on the CDT screen after being converted into a digital signal, processed with a PIP process in the scaler IC, and then converted back into an analog signal. During these processes, screen image quality may be degraded."

However, in paper no. 13, the Examiner argues that the MUX 202 has analog input and analog output without any D/A or A/D conversion. If this is true, then how is the analog uncompressed signal combined into a single picture-in-picture signal with the digital compressed MPEG signal? Furthermore, in col. 7, line 38 to col. 8, Cheney discloses the OSD blend process is *identical* to the already known OSD graphics over decompressed *digital* video alone. Furthermore, the process disclosed shows a digital function. If the output of the MUX is only analog, then how does the OSD perform its blend when the OSD process is clearly digital?

**2. Cheney fails to disclose a signal conversion unit (e.g., D/A converter) performing a conversion of the picture-in-picture signal output from the signal processing unit into an analog signal before the signal is output from the outputting unit (e.g., claim 2).**

In paper no. 13, the Examiner admits of a typographical error the previous office action, and asserts Cheney has a plurality of units performing the same functionality.

However, respectfully, a unit forming merely a D/A conversion is not a proper rejection in that it does not take into account the complete feature of the claimed invention. As mentioned above,

every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989).

Even if the Applicant were to assume for example the D/A converter from figure 2 is the signal converter, but then clearly it is not converting before the outputting unit. The outputting as claimed cannot be the display device as the "television" fails to disclose the elements of the outputting unit. Moreover, the display device is separately claimed.

Col. 6, lines 1-50 only states that the digital to analog conversion is made prior to output to the television system and not a signal conversion unit for converting the picture-in-picture signal output from the signal processing unit into an analog signal before a signal is output from the outputting unit and as shown above, the television system cannot also be the outputting unit.

The Examiner further stated that Cheney clearly teaches the D/A conversion on multiple occasions, for example, in figure 2 and in column 6, Cheney teaches digital-to-analog conversion of the video signal occurs prior to output 110 to the television system and that Cheney clearly teaches an A/D video decoder that meets the claim limitation of "an analog to digital converter unit" (See column 5-6 and 18) as well as a D/A video encoder that meets the claim limitation of "a digital to analog converter unit" (See column 5-6 and 18).

However, it is not important whether simply a D/A converter is disclosed, but that the D/A converter must be disclosed as *arranged in the claim* according to MPEP §2131. Cheney does not disclose signal conversion unit (*e.g.*, D/A converter) performing a conversion of the picture-in-picture signal output from the signal processing unit into an analog signal before the signal is output from the outputting unit as claimed by the present invention.

### **III. Withdrawal of Finality**

In paper no. 13, the Examiner removed the finality of 16 January 2003 but entered a new final rejection. The Applicant appreciates the withdrawal of the last rejection, however, the Applicant asks the new office action be made non-final because of the following.

First, the Examiner made paper no. 8 final, which placed the Applicant at a great disadvantage in prosecuting the present application, because only after paper no. 8 were some of the particular parts being relied upon were clear to the Applicant. This is especially important since as shown above, some of the Examiner admits, there was a typographical error on the part of the Examiner.

As mentioned in MPEP §706.07, “ Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public...present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is

justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application....The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.”

Therefore, by making paper no. 13 also final, this then never allowed the Applicant to properly prosecute the application as the finality for example prevents certain types of amendments.

Therefore, we ask the Examiner to first, withdraw the finality of the rejection of paper no. 13 and allow the Applicant to respond to a non-final rejection because of the harm that the Applicant may suffer from the pre-mature final which was admitted in paper no. 13. Entering another final rejection does still places the Applicant at a disadvantage and should be non-final office action according to MPEP §706.07.


In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant’s attorney.

No fee is incurred by this Amendment. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of



Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,

  
Robert E. Bushnell,  
Attorney for the Applicant  
Registration No. 27,774

1522 "K" Street, N.W., Suite 300  
Washington, D.C. 20005  
(202) 408-9040

Folio: P56597  
Date: 8/25/04  
I.D.: REB/SS